

REMARKS

Restriction Requirement

The Examiner, in the Restriction Requirement, required election of one of the following groups of claims:

Group I, claims 1-9, drawn to a method for selecting a dimerizing test polypeptide, class 435, subclass 7.8;

Group II, claims 10-15, drawn to a method for selecting a composite transcription factor, class 435, subclass 69.1;

Group III, claims 16-20, drawn to a method for detecting interaction between a test polypeptide and a DNA sequence, class 435, subclass 6.

Applicants hereby elect to prosecute the claims of Group I, claims 1-9, with traverse.

Applicants submit that the above Restriction Requirement is unduly burdensome and in error. MPEP §803 states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent and distinct inventions. (Emphasis added.)

The claims of Groups I, II and III are all directed to methods involving DNA-binding proteins. Therefore, Applicants believe that the claims of Groups I, II and III should be examined together as one group, as a single search is likely to find art related to all three groups of claims, particularly in light of the fact that all groups share the same class (class 435). Furthermore, Applicants submit that an examination of the claims of Groups I-III as one group would not impose a serious burden on the Examiner. Indeed, Applicants believe that failure to examine the claims as proposed would pose a far greater burden on the Patent and Trademark Office, by requiring a duplication of effort and resources, since a search directed to claims in Groups I through III would turn up overlapping art if such art existed. Additionally, imposing a three-way Restriction Requirement will cause a considerable expense to Applicants. Accordingly, Applicants respectfully traverse the above Restriction Requirement and request reconsideration thereof.

Election of Species Requirement

The Examiner, in the Election Requirement, required election of one species in 10 allegedly different groups (designated (a) through (j)). It was alleged that these groups have "different and separately burdensome manual and/or computer structure, name, and bibliographic

searches; and have divergent subject matter." (Restriction Requirement, page 4).

As a threshold matter, Applicants request that the election of species requirement be clarified. The Examiner has not indicated what the distinct species are considered to be and on what basis they are distinct. In particular, the election of species requirement does not indicate which species correspond to which Groups set forth in the Restriction Requirement. For example, the groups of species designated "(g) through (h)" on page 4 of the Restriction Requirement are relevant to Group III only and are not relevant to elected Group I. Therefore, clarification is requested.

In addition, the Election of species requirement fails to adequately set forth and define the allegedly distinct species. For example, no species are indicated in the allegedly generic "activation domain" of group (c). Accordingly, Applicants cannot select from unidentified species for their provisional election. Furthermore, in terms of defining the species, Applicants also request clarification. For instance, group (f) indicates that growth advantage and detectable signal are distinct when in fact a growth advantage is, in and of itself, a detectable signal. Accordingly, Applicants request that the Restriction Requirement be redefined and clarified.

Nonetheless, in order to comply with the requirement to elect a single species, Applicants provisionally elect, with traverse, the following:

- (a) prokaryotic host cells;
- (b) zinc finger proteins;
- (c) an activation domain;
- (d) HIS3 reporter gene;
- (e) zinc finger protein binding site;
- (f) a reporter gene giving a detectable signal.

As noted above, (g) through (j) are not relevant to elected Group I.

As noted above, Applicants traverse on the grounds that the election of species requirement is not adequately set forth. The Office has not delineated the differences between the allegedly distinct species encompassed by these claims and, accordingly, Applicants cannot be required to elect a single species, particularly where the choices are not even set forth. In view of the lack of clarity, Applicants request that the election of species requirement be withdrawn.

Applicants also traverse on the grounds that it would not unduly burdensome to search all allegedly distinct species together. Indeed, a search of the art for methods of using a DNA binding domain in a host cell to identify a dimerizing peptide would necessarily reveal art relevant to each and every host cell, DNA binding domain, activation domain, reporter gene (and signal) and binding site encompassed by the claims. For example, if the search for DNA-binding domains in a host cell to select a dimerizing peptide reveals no relevant art, there will be no

relevant art against (1) either eukaryotic or prokaryotic cells; (2) ZFPs in particular; (3) any activation domain used in conjunction with the DNA-binding domain; (4) any reporter gene (or signal); and/or (5) any binding site recognized by the DNA-binding protein, because, in **each and every** case, the components used in method claims 1-9 must result in selecting a dimerizing peptide. In view of the specific claim language, it is not required that each element be individually searched. Thus, because searching would be entirely routine and in **no** way burdensome, Applicants submit that the election of species requirement is improper and should be withdrawn entirely.

Finally, it is to be understood that the election of species is for the purposes of preliminary search and examination only, and that upon allowance of a generic claim, applicants will be entitled to consideration of claims to the additional species.

Applicants expressly reserve their right under 35 USC §121 to file one or more divisional applications directed to any nonelected subject matter during the pendency of this application.

Respectfully submitted,

Date: 9/23/03

By: *D. Pasternak*
Dahna S. Pasternak
Attorney for Applicant
Registration No. 41,411

ROBINS & PASTERNAK LLP
1731 Embarcadero Road, Suite 230
Palo Alto, CA 94303
Tel.: (650) 493-3400
Fax: (650) 493-3440